

Application No. 10/027,814
 Attorney Docket: 27006-0002
 Reply to Final Office Action of August 22, 2005

REMARKS

In the Final Office Action dated August 22, 2005, the Examiner: (a) rejects Claims 2-11 and 14-21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, (b) rejects Claims 2, 4-6, 10, 11, and 14-17 under 35 U.S.C. 103(a) as being unpatentable over Onozaki (JP 11-280548) in view of Shalman (USPN 6,332,556), (c) rejects Claims 2, 4-6, 10, 11, and 14-17 under 35 U.S.C. 103(a) as being unpatentable over Moller (USPN 4,395,982) in view of Shalman, (d) rejects Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Onozaki (JP 11-280548) in view of Shalman as applied to Claims 2, 4-6, 10, 11, 14-15, and 17, and further in view of Hofbauer et al. (USPN 4,296,716), (e) rejects Claims 7-9 and 18-21 under 35 U.S.C. 103(a) as being unpatentable over Onozaki (JP 11-280548) in view of Shalman as applied to Claims 2, 4-6, 10, 11, 14-15, and 17, and further in view of Takubo (USPN 4,770,276), (f) rejects Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Moller in view of Shalman as applied to Claims 2, 4-6, 10, 11, 14-15, and 17, and further in view of Hofbauer et al. (USPN 4,296,716), and (g) rejects Claims 7-9 and 18-21 under 35 U.S.C. 103(a) as being unpatentable over Moller in view of Shalman as applied to Claims 2, 4-6, 10, 11, 14-15, and 17, and further in view of Takubo (USPN 4,770,276). By this response, Applicant amends Claim 16 to address the rejection under item (2) above. In addition, Applicant has also amended Claims 10 and 16 to further clarify the invention and cancelled Claim 5. Claim 16 now clearly states the channels are continuous and extend downwardly. For the reasons stated herein Applicant respectfully submits that each of the pending claims (2-4, 6-11 and 14-21) are in a condition for allowance.

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Rejection Under 35 U.S.C. § 112 (as provided in item (a) above)

The Examiner rejected Claims 2-11 and 13-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention, stating that the drawings do not show the limitation that "the channels tapering downwardly from... the second end". Applicant has amended Claims 10 and 16 to clarify that the channels are "extending downwardly". Therefore, Applicant submits that this rejection is overcome and should be withdrawn.

Rejection Under 35 U.S.C. § 103(a) Over Onozaki In View Of Shalman (as provided in items (b), (d), and (e) above)

The Examiner rejected Claims 2, 4-6, 10, 11, and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over JP 11-280548 to Onozaki in view of U.S. Patent No. 6,332,556 to Shalman. Onozaki discloses an Oil Pan Structure for an Engine that improves rigidity of a boundary part of a deep bottom part and a shallow bottom part by integratedly forming reinforcing ribs for connecting a rear wall part of the deep bottom part and a bottom wall part of the shallow bottom part to each other. The Figures do show some grooves in the bottom of the deep bottom part, as pointed out by the Examiner, however Onozaki never discloses, teaches or suggests that these grooves are reinforcing. Furthermore, the reinforcing ribs in Onozaki are needed to support the oil pan wherein the present invention does not need the reinforcing ribs of Onozaki because the channels provide sufficient reinforcement.

In the Office Action, the Examiner indicates that Onozaki discloses an oil pan for an engine compartment comprising a plurality of substantially parallel, spaced apart, reinforcement channels (see Figure 3 bottom grooves) extending from an adjacent first end (23) of the oil pan to adjacent a second end (thinner area) of the oil pan, the channels tapering downwardly from the

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first end and the second end toward an accumulation area (see, Figure 1 flat circular portion 28) of the oil pan. The Examiner continues by stating that the oil pan has a main body, the main body having two side walls (21, 22), a first end wall (23), and a base (25), and wherein the accumulation area is integral with the base, the oil pan has a region of reduced height and the main body has a second end wall which tapers into the region of reduced height wherein there are no channels in the accumulation area. The Examiner further states that the channels in Onozaki extend up the first end wall but at a reduced height.

The Examiner admits that Onozaki does not disclose the channel walls along the base are of a height which is less than their height in the region of reduced height. To supplement the deficiencies of Onozaki, the Examiner uses Shalman to show channel walls along a base of a height which is less than their height in a region of reduced height. The Examiner then states it would have been obvious to one skilled in the art at the time the invention was made to modify the apparatus of Onozaki so as to provide channel walls along the base of a height which is less than their height in the region of reduced height in view of the teachings of Shalman in that such arrangement improves the ability of oil to collect in the reservoir.

Applicant respectfully points out to the Examiner that U.S. Patent No. 6,332,556 to Shalman is not analogous prior art in that it relates to a paint tray. To rely on a reference under 35 U.S.C. § 103, it must be analogous prior art (MPEP 2141.01(a)).

The courts have generally determined that a reference will be analogous art if: (1) it is of the same field of endeavor as the claimed invention; or (2) it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658-89 (Fed. Cir. 1992). Applicant respectfully submits that Shalman is not in the same of endeavor

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as the claimed invention and is not reasonably pertinent to the particular problem solved by the present invention.

Shalman is not within the same field of endeavor. As discussed below, the different classifications provide some evidence of non-analogy, such evidence being specifically to the field of endeavor. Applicant respectfully submits that the fields of endeavor as shown by the classification headings, and discussed below, are completely different and strongly support that Shalman and the present invention are not in the same field of endeavor. Furthermore, Shalman is directed to a paint tray assembly with a selectively engageable splash guard for a paint roller. A stackable tray assembly for paint rollers with an inclined surface and a paint reservoir and a splash guard configured for snap-on engagement with any part of the tray is clearly not in the same field of endeavor as an oil pan mounted to a lower portion of an engine. One skilled in the art would not be motivated to look at paint trays to solve a problem with oil pans or improve upon an oil pan that is mounted to an engine by reviewing paint trays. Also, in view of the problem to be solved, as discussed below, one skilled in the art would not be motivated to look to the field of paint trays.

Applicant respectfully points out that Shalman is classified in international class B05C 21/00 and U.S. classification 220/570; 220/731; 220/700. As stated in the MPEP and in *In re Ellis*, the Patent Office classifications of references and cross-references in the official search notes of the class definition are some evidence of non-analogy or analogy respectively. MPEP 2141.01(a) 476 F.2d 1370, 1372, 177 U.S.P.Q. 526, 527 (CCPA 1973). In the present case, the publication classification for the international classification and U.S. classification of the present application does not fall within any of the classes in which Shalman was classified or within the classes of the field of search for Shalman. Furthermore, other prior art oil pan references cited

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by the Examiner do not fall within any of the classes of Shalman. For example, U.S. Patent No. 4,770,276, U.S. Patent No. 4,296,716, and U.S. Patent No. 4,395,982 are all in international class F01M, not B05C of Shalman and primarily in U.S. classifications of Class 123 or 184, not 220 of Shalman. Shalman being non-analogous art is further supported in that under the U.S. classification system, Shalman has been classified in receptacle/paint trays, receptacle container attachment with splatter shield or deflector, and receptacle container attachment rim mounted. None of these classes are in any way related to oil pans for engines. In comparison, the present application has been classified, similar to U.S. Patent No. 4,770,276 in the lubrication-lubricators-drip pans classification. As stated above, not only are the U.S. classes different but the international classification of Shalman is also in a completely different section than the section in which the present application, as well as the other oil pans for engines have been classified. The specific international classification for Shalman is titled accessories or implements for use in connection with applying liquids or other fluid materials to surface and provided in groups B05C 1/00 to B05C 19/00. In comparison, the prior art cited by the Examiner has been generally classified into F01M which is lubricating of machines or engines in general; lubricating internal combustion engines; crankcase and ventilating and the present application has been put into international class F16N which is directed to lubricating and more specifically into F16N 31/00 which is directed to means for collecting, retaining, or draining off lubricant in or on machines apparatus. Applicant respectfully submits that the classification for Shalman as compared to the present invention and the other prior art cited by the Examiner (not including Shalman) are of completely different fields and as stated in the MPEP and in *In re Ellis* are of some evidence of non-analogy. Applicant has overcome the Examiner's rejection under items (b), (c), (d), (e), (f), and (g) and that all of the pending claims are allowable over the prior

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art cited by the Examiner, in that items (b), (c), (d), (e), (f), and (g) all include Shalman as a reference.

Applicant also respectfully submits that even if Shalman was analogous prior art, Shalman does not overcome the serious limitations of Onozaki. Applicant submits that Onozaki (1) does not include reinforcement channels, (2) does not include channels continuously extending from the first end to the second end, (3) even if the channels extend from the first end to the second end (as defined by the Examiner) then the oil pan would not have a region of reduced height and a main body between said first and second ends, and (4) does not include channels that slope downwardly from the first end wall **AND** the second end wall to an accumulation area. Therefore, Applicant respectfully submits that the present invention and the pending claims define over Onozaki.

Onozaki does not include reinforcement channels. Instead Onozaki discloses respective reinforcing ribs 11, 12, as shown in all of its Figures (specifically see Figure 1). As disclosed in Onozaki, these "respective reinforcing ribs 11, 12" "improve the rigidity of a boundary part of the deep bottom part 2 and the shallow bottom part 3". The Examiner cites the bottom grooves in Fig. 2 (which are not the reinforcing ribs) as reinforcement channels, however Onozaki never discloses, teaches, suggests or discusses any reinforcement through these channels. Therefore, Applicant submits that the bottom grooves are not reinforcement channels as claimed in the present invention and even if Shalman were analogous art, the present invention as defined in the pending claims, is in a condition for allowance.

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Rejection Under 35 U.S.C. § 103(a) Over Moller In View Of Shalman (as provided in items (c), (f), and (g) above)

The Examiner rejected Claims 1, 2, 4-6, 10, and 12-17 under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 4,395,982 to Moller of U.S. Patent No. 6,332,556 to Shalman.

Moller discloses a casing member for elements of internal combustion engines and more specifically a noise-reducing casing member for oil-containing elements of internal combustion engines. Moller states that the oil pan is formed from a casting to more effectively reduce the noise emissions and more specifically that the casing member is formed with grooved and/or step shaped walls, which allow direct molding and casting without difficulties and the plurality of ribs and corrugations prevent a uniform noise radiation surface and detune the natural frequency of vibrations. As may be seen in Figures 1-3, the channels are interrupted by each step and do not extend continuously from one end to the other end. More specifically, as shown in Figures 2 and 3, the steps inwardly are of about the same thickness as the channels and therefore the channels are interrupted at each step so that multiple small channel segments are formed instead of channels that extend from one end to the other end. In Moller, the channels also do not extend downwardly both from a first end wall (left end in Fig. 1) of the oil pan and from a second end wall of the oil pan (Fig. 1, proximate reference numerals 4, 5, and 6). Instead, the channels extend upwardly (assuming that Moller even has channels on the bottom of the deep part, as no channels are pictured in the figures or discussed in the specification, especially channels having a base, two sides and an open top) from the second end wall to the first end wall.

In the Office Action, the Examiner stated that Moller discloses an oil pan for an engine comprising a plurality of substantially parallel spaced-apart reinforcement channels (U shaped recesses in fig 2) extending from adjacent a first end (left end in fig. 1) of the oil pan to adjacent

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a second end (right end of fig. 1) of the oil pan, each channel having a base and two sides and an open top, the channels tapering downwardly from the first end to the second end towards and accumulation area (see fig. 2) of the oil pan wherein the reinforcement channels are substantially U-shaped. The Examiner admits that Moller does not disclose the channel walls along the base are of a height which is less than their height in the region of reduced height. To supplement the deficiencies of Moller, the Examiner uses Shalman to show channel walls along a base of a height which is less than their height in a region of reduced height. The Examiner then states it would have been obvious to one skilled in the art at the time the invention was made to modify the apparatus of Moller so as to provide channels walls along the base of a height which is less than their height in the region of reduced height in view of the teachings of Shalman that such arrangement improve the ability of oil to collect in the reservoir.

As discussed in detail above, Applicant submits that Shalman is not analogous art. Therefore, Applicant respectfully submits that this rejection is overcome and amended independent Claim 16 and the claims depending therefrom are in a condition for allowance.

Even if Shalman was analogous art, it does not supplement the deficiencies of Moller. Moller does not disclose (1) a plurality of substantially parallel, spaced-apart channels continuously extending from adjacent a first end of the oil pan to adjacent a second end of the oil pan, especially in view that the Figures and description do not disclose any channels (as defined in amended Claim 16) along the base of the deep part of the oil pan and (2) channels extending downwardly from the first and second end walls toward an accumulation area of the oil pan. Moller also does not disclose the limitations in the dependent claims.

Moller does not disclose a plurality of substantially parallel, spaced-apart channels continuously extending from adjacent the first end of the oil pan to adjacent the second end of

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the oil pan. In Moller, due to the step configuration, the channels do not extend from the first end to the second end. Instead, Moller includes a plurality of channels that end when the pan steps inwardly, as may be clearly seen in Figures 2 and 3. The hidden lines in Fig. 3, representing the channel have approximately the same depth as the base of the channel below and therefore, in Moller, the channels cannot extend from a first end to a second end. Fig. 2 also supports this in that the top view clearly shows the channels ending with each step. Shalman does nothing to supplement this deficiency and therefore, Applicant respectfully submits that Claim 16 and the claims depending thereon clearly define over Moller in view of Shalman. Furthermore, Moller does not disclose teach or suggest channels having a base, two sides, and an open top along the base of the deep part of the oil pan, as shown by the flat surface in Fig. 2 for the base and by the dotted line representing the base in Fig. 1.

The channels in Moller also do not extend downwardly from the first end wall and the second end wall towards an accumulation area integral with the base. As shown in Figs. 1 and 2, even if there were channels along the base of the deep part, the channels would extend upwardly from the second end wall (Fig. 1, proximate reference numerals 4, 5, and 6). Therefore, Applicant respectfully submits, that Moller clearly does not include a limitation of amended Claim 16, and that amended Claim 16 and the claims depending therefrom, clearly define over Moller in view of Shalman. The dependent claims provide further limitations that further define over Moller in view of Shalman.

It is respectfully submitted that the present amendment should be entered in accordance with the provisions of 37 C.F.R. Section 1.116 on the grounds that: (1) the claims as now presented are in better form for appeal purposes, if necessary; (2) no new issues have been

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raised; (3) and, moreover, the present amendment is believed to place the application in condition for allowance.

In view of the above remarks, Applicant respectfully submits that all of the pending claims are in a condition for allowance. If the Examiner believes that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at (248) 433-7285.

Prompt and favorable consideration of this amendment is respectfully requested.

Respectfully submitted,

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By: 

Richard A. Jones
Reg. No. 39,242
Attorneys for Applicant(s)

Dickinson Wright PLLC
1901 L Street NW, Suite 800
Washington, D.C. 20036
(248) 433-7285

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Enclosures

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